
In the
United States Court of Appeals
For the Ninth Circuit

No. 20,944

HARRY P. LOCKLIN AND ELMER J. BRANT, GENERAL
PARTNERS DOING BUSINESS UNDER THE FIRM NAME OF
RADIANT COLOR COMPANY,

Plaintiffs-Appellants,

vs.

SWITZER BROTHERS, INC.,

Defendant-Appellee.

FILED APPELLEE'S BRIEF.

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APPELLEE'S BRIEF.

COUNTER-STATEMENT OF THE CASE.

Radiant's "Statement of the Case" (ROB* 2) includes but fails to emphasize that this Court in its remand to the District Court (348 F. 2d 244, 246) directed:

"... that trial be had upon the sole question whether, in the 4-C resin, the amount of melamine utilized is such as to bring the resin within the limits of the claims of the Kazenas patent as those claims are delineated in our former opinion."

* ROB is the abbreviation used herein to designate Radiant's Opening Brief on this appeal.

In so remanding, this Court specifically stated, also at page 246:

“The record does not, however, suggest that trial upon any other issue is similarly justified under the circumstances. In all other respects the order of the District Court is entitled to affirmance.”

Such language clearly limits the scope of this Court's remand to “the sole question”, and to that alone. Consequently, Radiant on this appeal is precluded from directly or indirectly attacking the validity and scope of the claims, held valid and infringed by this Court (299 F. 2d 160), as Radiant is here attempting to do on the specious ground that new evidence adduced in this Contempt proceeding now renders such claims indefinite and not in compliance with 35 U. S. C. 112.

Such new evidence, Radiant contends, shows that there is no “simple, clear test” for determining that sufficient melamine is present in the 4-C resin to render it substantially insoluble in aromatic hydrocarbon solvents. In so contending, Radiant directly flouts this Court's holding (299 F. 2d 160 at 166) that:

“There is testimony to the effect that ‘sufficient melamine to render the resin substantially insoluble’ is a simple, clear test for an ordinary chemist to perform and one which does not require extensive experimentation in order that the precise critical limits be ascertained in a particular case. Under such circumstances, the fact that some preliminary testing is required *does not render the claim invalid for vagueness.*” (Emphasis supplied.)

The “simple, clear test” to which this Court had reference was the quick qualitative test, using toluene, that was independently adopted by both Radiant and Switzer, and used in the original trial, for evaluating the solubility or insolubility of the MSF resins in aromatic hydrocarbon

solvents. That test, as will be more fully explained later on in this brief, required only 24 hours, or, at most, less than a week to carry out. And it was on the basis of such test, using toluene as the exemplar of the "aromatic hydrocarbon solvents" of the claims, that this Court held the claims not invalid "for vagueness", or for "the use of functional language at the precise point of novelty".

But despite such final holding by this Court, Radiant seeks to show here that there is no "simple, clear test". It contends that the previously accepted quick qualitative test in toluene* is not the proper test, but that the evidence must show that the resin "remains" (in the sense of "continues to be") free flowing not only in toluene but also in benzene.

In so contending, Radiant is not only attempting to have this Court reverse its previous holdings based upon the toluene test as being "a simple, clear test" (which has now become "the law of the case") but also to have this Court reverse its ruling that: "The time for testing of proof is the time of trial" (299 F. 2d 160, 169).

Radiant, at the original trial, could have put in evidence that the toluene test is not adequate because of the shortness of time given for the test or because toluene is not exemplary of other aromatic hydrocarbon solvents, such as benzene. Not having offered such evidence as it could have produced at the original trial, Radiant should not now be permitted to introduce new (and clearly unreasonable) conditions into the quick qualitative test* that this Court found sufficient as "a simple, clear test" to support its holding that the claims are valid and free from vagueness or undue functionality.

On the basis of toluene being the proper aromatic hydrocarbon solvent for the quick qualitative test and a dura-

* Which Radiant accepted and used at the trial.

tion for the test of 24 hours or, at most, less than one week, there is no dispute between the parties that all of the 7-4-1 resins (absent the urea of the accused pigment) here before this Court are substantially insoluble in aromatic hydrocarbon solvents. Therefore, on this same basis, the answer to "the sole question" is that: "in the 4-C resin, the amount of melamine utilized is such as to bring the resin within the limits of the claims of the Kazenas patent as those claims are delineated in our former opinion."

**ONLY A SINGLE QUESTION IS PRESENTED
ON THIS APPEAL.**

Radiant's Question 1 (ROB 5) is the only question that Radiant can properly present on this appeal. It paraphrases "the sole question" presented by this Court's remand.

Radiant's Question 2 is not before this Court; it raises the issue of validity* of the claims in suit. This is *res judicata* no matter how adroitly Radiant may attempt to direct its question to whether there can be *infringement* by the accused pigments if such claims do not "truly comply" with Section 112.

This Court has already adjudicated the claims in suit to be valid. Such adjudication includes a ruling that the claims *do* "truly comply" with Section 112. The only question here in issue is whether the accused pigments and the 7-4-1 resins infringe the claims so adjudicated to be valid. As the Supreme Court held in *Graver Mfg. Co. v. Linde Co.*, 339 U. S. 605, 607:

"If accused matter falls clearly within the claim, infringement is made out and that is the end of it."

* Radiant admits that on the first appeal it attacked the validity of the Kazenas patent for claim indefiniteness (ROB 47-48). That was an attack for failure to comply with Sec. 112.

Switzer has already established in the first section of this brief that the accused pigments and the 4-C resins fall clearly within the claims adjudicated to be valid. The District Court on all of the evidence before it so found as a finding of fact (CT 115, 119).

**Radiant's Specification of Errors Includes "Findings"
Not Directed to the Sole Question on Remand.**

The word "Findings" in the above caption is purposely placed in quotation marks so as to include not only findings that the District Court made but also "findings" which Radiant charges the District Court failed to make and as to which Radiant assigns error.

From this Court's language in remanding on "the sole question" and its statement that the order of the District Court should stand "in all other respects", this Court quite evidently did not intend the District Court on this remand to go into matters not directly related to "the sole question", and therefore not material to the answering of such question; nor did it intend the District Court to make findings that would disturb its previous findings (not related to the sole question), made in the District Court's Memorandum of Decision of March 31, 1964 (CT 91-102) on which the Order of April 16, 1964 (CT 103-105) was based.

On the assumption that this understanding is correct, we challenge the "errors" listed by number in Radiant's Specification of Errors (beginning at ROB 5):

Specification 1—This alleges as error failure of the lower Court to find that certain of Radiant's tests "proved that the accused pigment is *not* one that will remain free-flowing in either of the aromatic hydrocarbon solvents benzene or toluene".

Since Radiant has asserted that Radiant "proved that the accused pigments would remain free-flowing in *both*

benzene and toluene for more than two years" (ROB 38), how can Radiant now consistently assign error to the District Court's failure to find that Radiant's tests prove the contrary?

The accused pigment referred to as "the 4-C resin" in the District Court's first Memorandum of Decision (CT 91) was admitted by Radiant (CT 97) to be "substantially insoluble in aromatic hydrocarbons" and the District Court so found (CT 101). This Court has stated that such a finding should not be disturbed (348 F. 2d 244, 246).

Radiant's witness, Mr. Bennahmias, testified (RT 374-378) as to the samples of the accused 4-C, R 104, pigment made by him in 1963 (R-38, in benzene, and R-39, in toluene), that the pigment was free-flowing in *both* benzene and toluene when made and were still free-flowing at the time of the trial.

Yet Radiant asserts as error in Specification 1 the District Court's failure to find that "tests made with Radiant's *inter partes* test resin* produced on September 2, 1965 proved that the accused pigment is *not* one which will remain free flowing in either . . . benzene or toluene".

Is Radiant now taking the position that the test results on Wayne test resin R-7 prove that the accused 4-C pigment is *soluble* in aromatic hydrocarbon solvents, contrary to its admission (RT 356) and to the District Court's earlier finding (CT 101)? Or is Radiant discrediting the Bennahmias 1963 test results the same as the District Court did (CT 112) in the case of the 1963 Bennahmias test results on the JS-738 resin in benzene (R-43) and in toluene (R-44)?

This Court's attention is also invited to the further point

* The particular "test resin produced on September 2, 1965", referred to in Specification 1 is not there identified but it is presumably "the Wayne test resin" (ROB 10-11), since Radiant states (ROB 14) that it is the "Wayne test resin R-7, upon which Radiant principally relies . . ."

that Specification 1 uses the word “remain” in the phrase “remain free flowing in either . . . benzene or toluene”. As we shall more fully point out later herein, the term “remain” is satisfied by a lapse of time of 24 hours, or at most, a test period of less than a week; and toluene, not benzene, is the aromatic hydrocarbon that was used in the original trial to evaluate solubility or insolubility in aromatic hydrocarbon solvents, and therefore the toluene quick qualitative test has become the “law of the case”.

Specifications 9, 10 and 11—These specifications assign error because the District Court failed to follow Radiant’s unreasonable and unsupported contention* that in order to establish insolubility in aromatic hydrocarbons the resin must remain free flowing and unagglomerated in *benzene* for such prolonged periods as “seven weeks”, or “at least as long as four months”. The “benzene test” is either directly referred to or is implied by use of the term “aromatic hydrocarbon solvents” to include *all* such solvents, and therefore benzene. These alleged errors do not go to “the sole question” for the reason, just given, that the quick toluene test of 24 hours or less than one week is the law of the case and if that test is met, then the resin satisfies the “substantially insoluble” limitation in the claims as delineated by this Court in its 1961 opinion.

Specifications 2 to 6 and 8, inclusive—These alleged errors all relate to non-essential matters, such as choice of particular types or brands of melamine and/or sulfona-

* Radiant’s contention is not only unsupported, it is directly refuted by the testimony of its own witness, Mr. Bennahmias, that if Radiant’s 24 or 48 hour test in benzene, toluene and xylene (RT 481-483) at 100° F. (RT 493) does not show agglomeration of the pigment, the pigment “has no defect” and “can be used in many systems in which they use aromatic hydrocarbon solvents . . .” (CT 114).

mides, or of particular process techniques. These are irrelevant matters in view of the District Court's earlier finding (CT 91-102, 97), that:

"Putting aside for the moment the question whether the new 4-C resin is completely condensed, the record does not disclose any factual dispute concerning the nearly identical relationship of the 4-C resin to the Kazenas claim. Radiant uses aldehyde, sulfonamide and melamine, the melamine being 18.45% by weight of the sulfonamide. The 4-C resins are thermoplastic. The three chemicals are present in the 4-C resin in proportions sufficient to render the condensation product substantially insoluble in aromatic hydrocarbons but insufficient to render it thermosetting. *Radiant admits that the 4-C resin is, in fact, substantially insoluble in aromatic hydrocarbons.*" (Emphasis supplied.)

The Court quite properly made no distinction between one melamine or another melamine*, or between one sulfonamide or another sulfonamide; nor did it draw a distinction as to the specific process used in making the 4-C resin and the process set forth in method claim 9 in suit.

The product claims in suit (Claims 1 to 4) are not restricted to melamine or sulfonamide in terms that distinguish from the melamine and sulfonamide used by Radiant in the accused 4-C pigment or in any of the 7-4-1

* Both buffered melamine and recrystallized melamine are melamine; there is nothing in the record to show that one had any different effect than the other on the resin made. Radiant's experts admitted they did not even know the pH of the reaction mass in Radiant's manufacture of the accused pigment (RT 451-453) so how could Radiant ascribe any importance to the difference in pH between its buffered melamine and Switzer's recrystallized melamine? Both had a basic, or alkaline, pH, not an acid pH as alleged in Specification 6. For, as Mr. Bennahmias testified (RT 433-434), the buffered melamine has a pH of about 8.1 and the unbuffered melamine has a pH of 7.2; both are on the alkaline side. And both "are of the same order of purity" (RT 644-645).

test resins here involved; nor is method claim 9 restricted to any special technique that might be employed, so long as the temperature used is one "up to 170° C." The temperature limitation is met by Radiant's use of temperatures, such as 163° C. (S-30; RT 189), that closely approximate the upper limit of temperature set forth in claim 9.

As to Radiant's contention (ROB 18) that by reason of the time-temperature conditions used by Mr. Gray "a different type of reaction occurred", this is fully rebutted by Dr. von Fischer's testimony (RT 646) that "we were basically at the same final temperature"; "the important temperature, of course, is the temperature of the mix".

With the exception of Radiant's Specifications 7, 12 to 14 and 23 to 25, which go directly and therefore properly to the sole question presented by the remand, none of the "Errors" alleged in the specifications, whether error in fact or not, is material to "the sole question" or in any way vitiates the ultimate holding of the District Court (CT 119):

"After a review of the entire record, as discussed in this opinion, the Court finds, in answer to the question presented here, that in the 4-C resin, the amount of melamine utilized is such as to bring the resin within the limits of the claims of the Kazenas patent as those claims are delineated in *Locklin v. Switzer Bros., Inc.*, 299 F. 2d 160 (9th Cir. 1961)."

As to whether any of the Findings of Fact should be set aside by this Court notwithstanding Rule 52(a) F. R. C. P., this will be discussed under the appropriate heading later on in this brief.

ARGUMENT.

The Evidence and Radiant's Admissions Establish That the Accused Pigments Do Contain Sufficient Melamine (Absent Any Urea) to Answer This Court's Sole Question in the Affirmative.

Under its sub-heading "Preliminary Discussion of Evidence on the First Question" (ROB 8), Radiant quite frankly states that "each test resin used the three essential ingredients (melamine, sulfonamide and formaldehyde) of the patented resin but in the same 7-4-1 molar proportions as used in the manufacture of the accused pigment" (ROB 9).

In so stating, Radiant admits that *in respect to the essential ingredients* these test resins satisfy the claims in suit regardless of what specific melamine or sulfonamide is used.

The test resins also satisfy the claim limitation as to aromatic hydrocarbon solvent-insolubility on the basis (which we submit is the only correct basis) of the quick qualitative test in which toluene is used and the duration of the test is 24 hours or, at most, less than one week. Radiant actually admits by the testimony of its own witnesses that the test resins of the 7-4-1 formula, without urea, meet the quick qualitative test in toluene. It therefore follows that these test resins necessarily and inherently satisfy the limitation in the claims as delineated by this Court in posing "the sole question".

The testimony to which we refer is the following:

With respect to the Wayne test resin R-7, "upon which Radiant principally relies" (ROB 14), Bennahmias testi-

fied, on the basis of the condition of the R-7 resin in toluene (R-9), that the Wayne test resin was "free flowing in toluene at the time of the trial" (RT 386), viz., some five or six weeks after the Wayne test resin was made on September 2, 1965.

With respect to the Bennahmias test resin R-16 (also designated as JS-738, CT 112), Bennahmias testified that at the time of the trial the R-16 resin in toluene (R-18) became "free flowing" when subjected to eight hard shakes (RT 418; ROB 19). This admission provided the basis for the District Court's finding (CT 113) that the condition of R-18 showed the Bennahmias test resin (R-16 or JS-738) to be free flowing in toluene. The District Court also found that the Bennahmias resin in xylene (R-19) was free flowing at the time of the trial (CT 113).

Thus the admissions made by Radiant's own witnesses as to the free flowing condition in toluene of both the Wayne and the Bennahmias test resins clearly establish that those 7-4-1 resins, without urea, meet the requirements of the claims as delineated by this Court. Since the 7-4-1 resins are admittedly identical, as to the essential ingredients, melamine, sulfonamide and formaldehyde, to the accused pigment but contain no urea, it follows from such admissions that, as found by the District Court, both the "accused 4-C resin" (meaning the accused pigment) and "the 4-C resin" (e.g., the 7-4-1 test resins) utilize sufficient melamine (by itself) to render each of them insoluble in aromatic hydrocarbon solvents (CT 117, 119). *Quod erat demonstrandum.*

The Gray test resin (S-5), a 7-4-1 resin (with no urea), was found by the District Court (CT 112) to have "remained free flowing and dispersed 24 hours after being placed in the pure solvents. Switzer also demonstrated at the trial that the [S-5] resin placed in the solvents on September 25, 1965, which had stood unshaken for 17 days,

was free-flowing upon being shaken at the trial.” The “pure solvents” referred to by the Court were benzene, toluene and xylene.

Radiant’s only complaint as to the 7-4-1 Gray test resin was as to insignificant differences in its manufacture as compared with the manufacture of the accused 4-C resin by Radiant. As to such differences, the District Court stated (CT 115):

“The Court finds no merit in Radiant’s contention that the results are not reliable because of certain differences between the kind of melamine* Switzer used in its qualitative tests and that used by Radiant, and because of certain differences in the method of preparation of the test resin by Switzer.”

As to the Gray test being a laboratory experiment, so was the Bennahmias test a laboratory experiment (ROB 11). And as to the time-temperature relationship used by Mr. Gray, Dr. von Fischer (RT 646) fully rebutted Radiant’s contention that “a different type of reaction occurred”. (ROB 18)

The District Court’s finding that there was “no merit in Radiant’s contention” was fully justified by the evidence and should not be disturbed.

The District Court Correctly Found That a Lapse of Time of Less Than a Week Was Sufficient for Evaluating Insolubility by the Quick Qualitative Test.

As is apparent from a reading of the excerpts (quoted at ROB 23-24) from the District Court’s Memorandum of Decision (CT 111-113), the District Court recognized that

* As to the melamine used in making the Gray test resin (S-5), Radiant’s expert, Dr. Huber, admitted, with reference to the Chart of claim 2 of the patent (R-59), that “there is nothing on this illustrative chart that requires any particular melamine” (RT 618).

there was “a dispute over how long the resin must remain without coalescence or agglomeration to come within the defining words of the patent claim: ‘substantially insoluble in aromatic hydrocarbon solvents’.” But the Trial Court then proceeded to make as a finding of fact that “. . . the 24 hour and 17 day qualitative tests conducted by Switzer . . . are simple clear reliable tests, which demonstrate that, *in fact* the accused 4-C resin contains sufficient melamine to render it substantially insoluble in aromatic hydrocarbon solvents” (CT 115). (Emphasis supplied).

Where there is a dispute as to what the evidence shows, the trier of the facts is in the best position, because of its “opportunity to judge of the credibility of the witnesses”, to decide which disputant’s evidence is entitled to the greater weight, and its decision should not be lightly overruled (F. R. C. P. 52(a)). The primary issue here is a fact issue. It is not a legal issue, as Radiant contends, for the simple reason that this Court had already delineated “the limits of the claims” in its former opinion; it remanded to the District Court “the sole question” for a fact finding, and that only.

Radiant contends (ROB 28) that this Court’s use of the word “remains” in the clause “which remains insoluble without agglomeration in aromatic hydrocarbon solvents” is used in the dictionary sense, “to continue unchanged . . .”, and thus “is not limited by time”.

Such a contention leads to a “*reductio ad absurdum*” situation. As Dr. von Fischer stated in answer to a question on cross (but only in the context of the question), the resin would have to stand in a suspended condition “forever” (RT 256). Surely this Court did not mean the resins must “remain insoluble” [*forever*] “without agglomeration in aromatic hydrocarbon solvents”. (Bracketed word supplied).

Such an interpretation of this Court's language would mean that no *quick* qualitative test could be used for evaluating insolubility. Yet both the original Trial Court and this Court, in holding the patent claims valid and infringed, implicitly relied upon the 24-hour or the less than one week tests in toluene, such as were made on the patented resins by Radiant and were put in evidence in the original trial. The "less than one week" test in toluene was accepted by the District Court on the basis of its adoption at the original trial (CT 112).

Judge Goodman's refusal (OR 135) to accept tests of Radiant's expert, Mr. Paulsen, was because of the manner in which he carried out some of the methods of the Patent Examples. There is no justification whatsoever for Radiant saying (ROB 29) that "Judge Goodman expressly rejected as being 'not reliable' the only solubility tests based on a one week observation". The term "a one week observation" is not even used or implied in Judge Goodman's holding that: "The experiments performed by Plaintiff's expert . . . are not reliable evidence . . ." (OR 135).

This misrepresentation of what Judge Goodman ruled is inexcusable.

So is Radiant's conclusion (ROB 29) that the District Court and Switzer "have disowned Dr. Hatcher's tests and testimony". Such tests were as to Dr. Hatcher's resin sample of Example 5 of the patent. The tests showed that this resin sample was still free-flowing in toluene upon examination at the trial four months after the date when made. Judge Goodman, in accepting this sample as being within the claims in suit, because insoluble in aromatic hydrocarbon solvents, did not require any particular length of time for evaluating either that or other resins of the patent, nor did he even comment thereon; but he *did* accept the testimony of Radiant's expert, Mr. Paulsen, that samples of the resins of Examples 1, 3 and 6 of the

patent, which were tested in toluene after a lapse of time of less than a week, were insoluble (OR 278-279).

Although admitted by Radiant at the original trial to be insoluble in aromatic hydrocarbon solvents, these same resins of Examples 1, 3 and 6 (S-19, S-18 and S-20, respectively) at the time of the evidentiary hearing on Contempt were in a plugged or caked condition in toluene (RT 88-94)! This one fact makes it clearly obvious that the lapse of time required for the qualitative test in evaluating resins for substantial insolubility cannot be "forever", nor should this Court's use of the term "remain" be construed in the dictionary sense of "to continue unchanged", without any limit as to time.

Whenever a pigment is suspended in a liquid vehicle it tends to settle out on standing, e.g., a paint pigment in an oil vehicle. The suspended pigment ultimately settles and packs or cakes at the bottom of the container. It does not "continue unchanged". The Mil Spec. (S-43 for identification) clearly recognizes such tendency of resin pigments to settle, even to the extent of requiring a paddle to redisperse them. (cf. p. 4, 3.7.1) Even resins that had stood in toluene for less than a week and that Mr. Paulsen testified were insoluble in aromatic hydrocarbon solvents settled out but could be redispersed by shaking or by the use of a spatula (OR 277-279).

In contrast, the admittedly soluble Japanese resin (S-15) almost immediately started to lump and was not redispersible upon being placed in toluene (S-17) in the Court demonstration carried out by Mr. Gray (RT 78-83). Mr. Gray had never seen a 7-4-1 resin that had as quick a coalescence as observed in this court demonstration of the Japanese resin (RT-185).

In view of this court demonstration, it must be clearly evident that all of the 7-4-1 resins have a much greater

degree of insolubility in toluene than the closest prior art resin, viz., that of the Japanese patent. The use of the phrase "remain free flowing" takes on real significance by virtue of this vast difference between the Japanese resin and the 7-4-1 resins in point of time required for agglomeration or coalescence when subjected to the quick qualitative test in toluene. The adoption by the District Court of the 24 hour or less than a week test period is not only justified because it has become the law of the case, but because it places a reasonable finite time limit upon the word "remain" or "remains" as used in the decision of this Court (299 F. 2d 160, 162-163).

Switzer agrees that both it and Radiant alike are now bound by this Court's earlier decision (ROB 29). It is Radiant that wrongly urges its freedom to contest such earlier adjudication, not Switzer.

Switzer did not induce this Court to hold the claims valid on the basis of any different insolubility test than the toluene quick qualitative test that Switzer has used in this Contempt proceeding. The District Court adopted such test in its findings.

There were no "insolubility tests lasting more than four months" on the basis of which Switzer induced this Court to hold the claims valid. As this Court said in its decision (299 F. 2d 160, 169) with respect to the Hatcher test, carried out on a resin sample identified as Dx N (ROB 27):

"If the fact was that the resin would agglomerate and would not remain free flowing, Radiant could have established this by its own pre-trial experiments and have introduced evidence with respect to those experiments at the proper time."

This admonition, clear from the above quoted ruling of this Court, is equally applicable to evidentiary matter that Radiant now seeks to rely upon and that it could have

brought into the original trial on the issues of infringement and validity.

The very voluminous record of the original action, C. A. 36,995, will reveal that Radiant brought numerous motions (several amounting to motions for a new trial on the basis of allegedly "new evidence"). All such motions were denied. Radiant mentions only one such motion* (ROB 27). The decisions denying those motions, affirmed by this Court (299 F. 2d 160, 169), constitute a further bar against Radiant's right to use here the same or other "evidence" on the same issue that it could have introduced into the original trial. None of the evidence as to the sufficiency of the toluene quick qualitative test for evaluating insolubility of resins in aromatic hydrocarbons, here used by Switzer to establish the answer to the present issue of whether the 4-C resin utilizes sufficient melamine etc., is evidence that Radiant could not have introduced in the original trial on the issue of the validity and scope of the claims in suit.

The District Court Properly Included Benzene; The 24-Hour Qualitative Test Showed the 7-4-1 Resins To Be Insoluble in Benzene.

Radiant's statement in its heading "The District Court erred in defining aromatic hydrocarbon solvents" (ROB 20) is palpably untrue. The very finding of the District Court that Radiant quotes in support of such alleged error shows that the District Court properly included benzene in the term "aromatic hydrocarbon solvents" for such finding

* This was a Motion for New Trial (OR 211-219) in which Radiant charged Switzer with misrepresentation as to the Kazenas resin being substantially insoluble in aromatic hydrocarbons because of Switzer's "failure to produce any examples of Kazenas resin suspended in benzene, which plaintiffs now believe to be a stronger aromatic hydrocarbon solvent than the toluene solvent used by the parties at the trial . . ." (OR 215).

names benzene as "the strongest of the three aromatic hydrocarbon solvents."

The District Court justifiably adopted toluene, rather than benzene, as the solvent to be used in the quick qualitative test, since toluene was the aromatic solvent used in the original trial in the qualitative test that this Court termed "a simple, clear test" for evaluating the "substantial insolubility in aromatic hydrocarbon solvents" of the patented resin.

The District Court could just as well, however, have based its finding of aromatic hydrocarbon insolubility on the 24 hour qualitative test using benzene, since the Gray test resin and the Wayne test resin, both of them 7-4-1 resins, were dispersible in benzene for at least 24 hours and were therefore insoluble in benzene, in addition to toluene and xylene, on the basis of the 24 hour quick qualitative test.

As to the Switzer-made 7-4-1 resin (S-5), that resin in benzene (S-6) was still free flowing at the time of the trial, 17 days or so after it was made on September 25, 1965 (RT 194-195; 201). The same resin (S-5) at the time of the trial was also free flowing in toluene (S-7) and in xylene (S-8) (RT 201-202).

As to the Radiant-made Wayne test resin (R-7), this also was a 7-4-1 resin, but made in the inter partes test on September 2, 1965 (RT 202) and offered by Switzer as S-33. Dr. von Fischer testified that from September 20, 1965, when this resin (S-33) was placed in benzene (S-34), until October 12, 1965, a date during the evidentiary hearing, the resin was found to be dispersible at each daily inspection on slight shaking. From this Dr. von Fischer concluded, based upon this qualitative test, that the resin (S-33), or (R-7), is insoluble in benzene (RT 203). The same resin (S-33) when dispersed in toluene

(S-35) was also dispersible and therefore insoluble in toluene. No test was made in xylene since Dr. von Fischer believed it would certainly be dispersible in xylene if it were in both toluene and benzene (RT 205-206).

Since the Wayne test resin (R-7) was the resin "upon which Radiant principally relies" (ROB 14), the uncontested finding by Dr. von Fischer that the R-7 resin was insoluble in benzene should be sufficient proof that the 7-4-1 resin is insoluble in benzene, as well as in toluene and xylene on the basis of a 24 hour qualitative test.

Radiant's attempt to discredit the 24 hour qualitative test should be rejected, just as the District Court did and for the same reasons (CT 113-114).

Switzer is not attempting to reconstrue the term "aromatic hydrocarbon solvents" so as to eliminate benzene (ROB 22); it submits, however, that the limitation in the claims is satisfied by the use of toluene as the exemplar of "aromatic hydrocarbon solvents" in the quick qualitative test that became the "simple, clear test" referred to by this Court in affirming Judge Goodman's adjudication of validity (299 F. 2d 160). Switzer agrees with Radiant that the claims in suit "must now be construed on the contempt hearings in a manner consistent with their validity" (ROB 23); Switzer, however, submits that this is being done by giving effect to the toluene test as the "law of the case".

Radiant argues (ROB 22-23) that the claims of the patent in suit require that the insolubility of the resin be tested in *all* aromatic hydrocarbon solvents, citing *Corona Co. v. Dovan Corp.* (1928), 276 U. S. 358 and *Graver Mfg. Co. v. Linde Co.* (1949), 336 U. S. 271. The facts of these two cases make them clearly inapplicable to the fact situation presented here. In *Corona*, the patent claimed certain broadly defined guanadine derivatives for use as accelerators for the vulcanization of rubber. In *Graver*, the patent

claimed welding fluxes comprising certain broadly defined silicates as ingredients. In both cases the broadly defined compounds were the crucial components of the composition that was claimed to be novel.

In contrast, the aromatic hydrocarbon solvents here referred to are not named as components of the claimed resin composition. The claims are directed to the resin, *per se*, or to the method of making the resin. Aromatic hydrocarbon solvents are mentioned in the claims in suit only in connection with a test which serves to identify those resins that include a sufficient amount of melamine to impart to the resins desired insolubility characteristics.

On the basis of the testimony of credible experts in the original trial and in the evidentiary examination, the toluene test was held sufficient to establish the substantial insolubility of the MSF resins in aromatic hydrocarbon solvents.

Such holding should not be disturbed for the same reasons as this Court deemed sufficient in *Research Products Co., Ltd. et al. v. Tretolite Co. et al.* (9 Cir. 1939), 106 F. 2d 530, 534:

“We conclude that the finding of the court and special master as to the meaning of the patent is sustained by the testimony of credible experts appearing before the special master and that the finding should not be disturbed insofar as it is drawn in question here. If it is indefinite in some respects due to the comprehensive character of the invention and of the claims therefor, it is not uncertain in the area of description involved in this action. Any vagueness in those outlying boundaries of the description does not invalidate the patent as to that which is clearly defined. *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U. S. 403, 22 S. Ct. 698, 46 L. Ed. 968; *Faultless Rubber Co. v. Star Rubber Co.*, 6 Cir., 202 F. 927.”

The Trial Court found the toluene test to distinguish the claimed resins patentably from the prior art resins, such as the resin (S-15) of the Japanese patent.

Inasmuch as the 7-4-1 resins have also been shown by credible witnesses to be insoluble by the 24 hour qualitative test using benzene, Radiant's contention (ROB 23), that its specifications of error 9 and 10 should be sustained, should be rejected. There is no matter of law here involved but only a fact issue, and that has been decided by the District Court.

The Trial Court Properly Considered the Quantitative Test Results Along With the Quick Qualitative Test Results.

In contending that the District Court erred in considering quantitative tests of solubility (ROB 33 *et seq.*), Radiant uses a sledge-hammer in its attempt to kill a gnat. Before even considering the quantitative test results, and therefore solely on the basis of the results of all of the qualitative tests, the District Court held (CT 115-116) as follows:

“The Court, however, in no wise suggests that the above tests represent the minimum standard for determining the question presented or that the 24 hour qualitative test, alone, would not suffice for determining the question here. The Court merely holds that the above tests when considered together do in fact show *beyond any doubt* that the accused 4-C resin contains sufficient melamine to render it substantially insoluble in aromatic hydrocarbon solvents.” (Emphasis supplied.)

The District Court then proceeded to make its findings with regard to the 24 hour quantitative test (CT 116):

“In addition to the above qualitative tests made by Switzer, Switzer also made a 24 hour quantitative test. In this test a carefully measured portion (.10 grams) of the JS-738 resin (which was a sample resin

made by Radiant but without any urea) was deposited in 50 milliliters of each of the three pure solvents. In addition, a carefully measured portion of the JS-739 resin (also a sample made by Radiant but containing a half-mole of urea) was deposited in 50 milliliters of each of the three pure solvents.

“After allowing all of these solutions to stand for 24 hours, Switzer determined how much of the resin had gone into solution, *i.e.*, the solubility. Switzer determined that in benzene, .020 grams of the JS-738 resin had dissolved per 100 milliliters of benzene, while .010 grams of the JS-739 resin had dissolved per 100 milliliters of benzene. In toluene, Switzer determined that .007 grams of the JS-738 resin had dissolved per 100 milliliters of toluene, while .002 grams of the JS-739 resin had dissolved per 100 milliliters of toluene. In xylene, Switzer determined that .003 grams of the JS-738 resin had dissolved per 100 milliliters of xylene, while .002 grams of the JS-739 resin had dissolved per 100 milliliters of xylene.”

The first above quoted holding, which is based solely on the qualitative test results, is a finding of fact that fully answers the sole fact question put to the District Court on the remand. The District Court could have stopped at this point, since it had found the ultimate fact that this Court left for the District Court’s determination. Such finding should be allowed to stand. Rule 52(a).

Based upon the just recited quantitative test results, however, the District Court further found (CT 117):

“... the results of the quantitative tests with the JS-738 resin *substantiate* the findings of this Court with regard to the qualitative tests, to wit: that the accused 4-C resin contains sufficient melamine to render it substantially insoluble in aromatic hydrocarbon solvents.” (Emphasis supplied.)

Switzer respectfully submits that the finding “beyond any doubt” (CT 115) of the ultimate fact, based as it was upon the qualitative test results, required no substantia-

tion by the quantitative tests. That being so, Switzer prefers not to burden this Court with an extended and probably unnecessary answer to Radiant's intricate and unconvincing arguments as to why the quantitative results should not be given credence.

In declining to answer Radiant *in extenso* on this matter of the quantitative tests, Switzer respectfully points, however, to the following evidence that the 24 hour quantitative test is a proper length of time for the test and that the 24 hour quantitative test establishes insolubility of the 7-4-1 resins in toluene:

(1) The 24 hour test had its origin in the selection of 24 hours by Radiant's affiant, Dr. Robert D. Kross, S-38, in his quantitative solubility tests on various MSF resins. In Dr. Kross' Affidavit (S-38, at p. 4) he specifically pointed out that containers of the resin and solvent, used in his quantitative solubility tests, "were allowed to *remain* for 24 hours at ambient temperatures, *to assure the full attainment of equilibrium.*" (Emphasis supplied);

(2) In a pre-trial discovery deposition of Radiant's expert, Dr. Huber (S-48), Dr. Huber was asked (RT 623) the following question and gave the following answer:

Q. "Now, if a substance were soluble to less than a tenth of a percent would that be substantially insoluble?"

A. "Yes".

(3) Dr. von Fischer's tabulation of Quantitative Solubility Measurements (S-39) shows much less than 0.1% solubility (approximately equivalent to 0.1 grams of resin in 100 ml. of solvent) for all the resins, S-5, S-33, S-36 and S-37, even in benzene, and between 0.002 and 0.007% solubility in toluene;

(4) Dr. Weiner, one of Radiant's experts, by his chart of the Quantitative Solubilities of Resins (R-48), showed

that of the three inter partes test resins, R-16, S-5 and R-7 resins, the R-16 resin (also called the Bennahmias JS-738 resin) evidenced the highest degree of solubility (in a 24-hour test, standing at room temperature in toluene), to wit, 0.014 grams/100 ml. of toluene. This same chart gives the solubility of the resin of Example 5 of the patent as 0.041 grams/100 ml. of toluene, almost three times the solubility figure of 0.014 for the R-16 resin. Since the patent Example 5 resin was found by Judge Goodman (OR 138) to be substantially insoluble in aromatic hydrocarbons, certainly the three times more insoluble Bennahmias test resin R-16 should also be held insoluble on the basis of Dr. Weiner's own quantitative tests, all carried out under identical conditions.

(5) The same Weiner chart (R-48) shows the Japanese resin (S-15) to have a solubility 0.180 grams/100 ml. of toluene. This means that the Japanese resin was found by Dr. Weiner to be thirty-six (36) times more soluble in toluene than the Gray test resin (S-5), for which Dr. Weiner's figure is 0.005.

(6) Dr. von Fischer testified (RT 237-238; 313-316) based upon his knowledge and experience that since the 7-4-1 resins here in evidence all met the qualitative and quantitative tests (meaning the 24-hour tests), they would be satisfactory for use as pigments in common paint vehicles* and would not coalesce on standing, and would

* The patent in suit supports a distinction in degree between the insolubility of the Kazenas resin in "many common vehicles" (*e.g.*, paint vehicles) "without coalescence or agglomeration" (column 1, lines 57 to 60), and the "*practically* insoluble" characteristic of the pigments of such resins "in aromatic hydrocarbon solvents" (column 6, lines 4 to 8). (Emphasis supplied) As the District Court found (CT 114): "Pure hydrocarbon solvents are never used alone with resin in a paint vehicle, but only in conjunction with other liquids and substances which in effect reduce the strength of the pure solvent."

meet the requirement in that respect of Mil. Spec. (S-43 *id*);

(7) The dictionary definition of "insoluble" (S-42) is: "not dissolving except in very minute quantities."

With the foregoing evidence before it, the District Court held (CT 116-117) that:

"It appears, therefore, that in the 24 hour period only very minute quantities of the JS-738 resin and of the JS-739 resin went into solution. Although these quantitative tests were not before the Court in the original infringement trial in 1959, the Court finds that the results of the quantitative tests with the JS-738 resin substantiate the findings of this Court with regard to the qualitative tests, to wit: that the accused 4-C resin contains sufficient melamine to render it substantially insoluble in aromatic hydrocarbon solvents."

Urea Is Not Responsible for the Insolubility of the Accused Pigments; Melamine Is.

Although seeming to agree with the District Court that the question of whether urea produced substantial insolubility of the accused pigments "is not the determinative issue" (ROB 36), Radiant nevertheless attempts by obscure reasoning to find support for its contention that the District Court erred in its findings to which Specifications 21 and 22 are directed, *viz.*, to this same non-determinative issue.

The District Court quite correctly said that this issue "is not the determinative issue referred to this Court by the Court of Appeals" (CT 117-118). It said this, however, after making its finding of fact "that the accused 4-C resin contains sufficient melamine to render it substantially insoluble in aromatic hydrocarbon solvents" (CT 117). That was the determinative issue. What the District Court held as to this non-determinative issue may be superfluous, but is nevertheless directly supported by the evidence to

which the District Court referred in making the allegedly erroneous findings.

Before considering Radiant's feeble attempt to distort the effect of such evidence, let us first consider the following admission made by Radiant's expert, Mr. Bennahmias (CT 446):

“According to my experience, I am positive that you could make a resin of the 7-4-1 proportions and obtain substantially (sic) insolubility in aromatic hydrocarbon solvents.” (RT 446)

We submit that this categorical statement is binding upon Radiant as an admission that a 7-4-1 MSF resin (without urea) can be made that is substantially insoluble in aromatic hydrocarbon solvents. If such a 7-4-1 resin can be made, then certainly it would have to be the melamine that is responsible for the insolubility of the resin; it could not be urea, because the question that Mr. Bennahmias was answering was limited to “the three essential ingredients, melamine, sulfonamide and formaldehyde . . . in the 7-4-1 proportions.” (RT 445.)

With that as a background, it should not have been surprising to Radiant that the Gray test resin S-5, a 7-4-1 resin without urea, met all the tests for substantial insolubility in aromatic hydrocarbon solvents, not only the toluene sample (S-7) and the xylene sample (S-8), but also the benzene sample (S-6) (RT 194-202). All of these samples remained free-flowing when the containers were inverted and shaken at the trial (RT 201-202). The elapsed 17 days (between making and shaking these samples at the trial) is a longer period of time than the maximum one-week period deemed sufficient by Radiant (OR 278-279) in the original trial for Radiant to establish insolubility in toluene (and therefore in aromatic hydrocarbon solvents) of the resins of Examples 1, 3 and 6 of the patent (here in evidence as S-19, S-18 and S-20, respectively.)

Radiant (purposely, we submit) makes no reference whatsoever in its Brief to the above evidence as supporting the Court's findings (CT 117-118). Instead, Radiant makes the unsupported, but at the same time unequivocal, statement that "the only meaningful evidence in the case shows conclusively that the urea used in the manufacture of the accused pigments contributes substantially to the insolubility of the resin" (ROB 36).

Such "evidence" as Radiant refers to (ROB 37-39) is far from conclusive.

Radiant's showing at the time of the evidentiary hearing in this Contempt proceeding was that the JS-738 resin (a 7-4-1 resin without urea, identified also as R-16) "had agglomerated in benzene after seven weeks (Pex R-17; RT 417)."

However, as to this same Bennahmias test resin R-16, Bennahmias testified (RT 445) that he did not know for sure whether he observed the sample in benzene (R-17) after the first day, so he could not say whether it was dispersible in benzene for 24 hours or not.

This Court is fully justified, therefore, in disregarding Radiant's arguments as to the benzene insolubility of the 7-4-1 resins based upon the agglomeration of the R-16 (or JS-738) resin in benzene after a lapse of 7 weeks (ROB 37).

Nevertheless, on the basis of Radiant's evidence as to the agglomeration in benzene of the JS-738 resin, made without urea, Radiant draws the *non-sequitur* conclusion that "it thus became completely unnecessary and irrelevant for Radiant to show the effect of urea in making the accused pigment" (ROB 37).

Switzer, however, supplied the evidence as to the *lack* of effect of urea by introducing Radiant's own test of the JS-739 resin made by Mr. Bennahmias at the September 3, 1965 *inter partes* test. Upon Radiant's failure to offer

this JS-739 resin in evidence, Switzer offered it as Switzer Exhibit, S-37. This was a 7-4-1-0.5 resin, *viz.*, a 7-4-1 resin with half a mole of urea added. The District Court's own examination of the condition of the JS-739 resin in benzene (S-46) confirmed Mr. Bennahmias' admission (RT-472-473) that this urea-containing resin agglomerated in benzene: ". . . this JS-739 (with urea) was in the same agglomerated condition as the JS-738 resin (without urea), and Mr. Bennahmias so admitted" (CT 118).

Radiant weakly maintains that this agglomeration of the urea-containing resin in benzene "does *not* demonstrate that the urea had no effect on the solubility of 7-4-1 resins" (ROB 37). The District Court held otherwise, but offered alternative conclusions in so holding (CT 119):

"Our conclusion is that (1) either Radiant's contention that its '4-C resins are rendered substantially insoluble in aromatic hydrocarbon solvents by using urea in addition to melamine' is wrong or (2) the benzene tests which showed that after seven weeks the JS-738 resin (without urea) and the JS-739 resin (with urea) had agglomerated do not disprove that either resin is substantially insoluble in aromatic hydrocarbon solvents."

In complaining (ROB 37) that "it is anomalous" that the Court should "use benzene tests as a basis for evaluating the comparative solubilities of the JS-738 and JS-739 resins", Radiant completely disregards what the Court said in the second part (2) of its above quoted conclusion. A seven-week duration for the benzene tests is wholly too long. For any quick test to be useful, it must really be quick, not one that requires seven weeks, four months or something approaching eternity as Radiant wants the word "remain" to be construed.

The District Court's conclusion as quoted above is the only correct one to be drawn. It should be affirmed as a fact finding of the Trial Court (F.R.C.P. 52(a)).

That rule is particularly applicable to this finding since the Court's rejection of the evidence as to the 1963 Bennahmias resins JS-738 and JS-739 (on which Radiant seeks to rely, ROB 37) was because the tests on those resins "were not conducted under the observation of Switzer" (CT 113). If this reflects upon the credibility of Radiant's witness, Mr. Bennahmias, the "due regard" clause of Rule 52(a) should be given effect in evaluating all test results on resins made by Bennahmias in 1963. These include the tests in benzene and toluene of the R-38 and R-39 resins (both said to be 4-C pigments prepared by Bennahmias on or around July 2, 1963) and referred to by Radiant (ROB 38-39).

Actually, as to the JS-738 and JS-739 resins, made by Mr. Bennahmias in 1963, his own testimony (RT 407-408; 516-517) shows that neither of these resins agglomerated in toluene (R-44 and R-47) within 24 hours or within a period less than one week. So both of these resins, the 7-4-1 resin (without urea), and the 7-4-1-0.5 resin (with 0.5 moles of urea) passed the toluene quick qualitative test that we submit is the law of the case. That the JS-739 resin (with urea) "remained free flowing" longer than the JS-738 resin (without urea) is of no real significance here, since both resins met the toluene test approved by the Court.

What Radiant contends or does not contend as to whether the JS-738 or the JS-739 is usable as a substitute for Radiant's 4-C resin (ROB 39) is beside the issue here. Radiant has not established that the half-mole of urea in the accused pigments is *necessary* to render such pigments "substantially insoluble" within the delineation of that term by this Court. The melamine content, by itself and without any added urea, has been established to be sufficient for that purpose.

This was the "sole question" before the Trial Court on

remand by this Court. The District Court has restricted its Memorandum of Decision (CT 107) to this sole question and has answered it in the affirmative. Its findings of fact are not “clearly erroneous”; the Trial Court had “the opportunity to judge of the credibility of the witnesses”; and “its findings should not be set aside.” F. R. C. P. 52(a).

Rule 52(a) Does Control the Issue on This Appeal.

Under its heading contrary to the above, (ROB 12), Radiant cites several cases in support of its contention that “the issues presented on this Contempt appeal do not depend so much upon credibility of witnesses as they do upon the construction of the Kazenas patent claims and the earlier decision of this Court”.

Switzer takes exception to this quoted contention. The credibility of the witnesses is a factor, since Radiant’s criticism of much of Switzer’s evidence, *e. g.*, as to the Gray test resin, was quite evidently rejected by the District Court after judging of the credibility of the testimony of Radiant’s witnesses as against the credibility of Switzer’s witnesses. The District Court must also have judged of the relative credibility of witnesses in rejecting the testimony of Mr. Bennahmias and accepting the testimony of Dr. von Fischer on disputed points.

As to the construction of the Kazenas patent claims, the construction that controls here is that already placed on the claims by the 1961 decision of this Court. There was left, therefore, only factual findings for the District Court to make on the remand to it of “the sole question”.

The *Union Carbide v. Graver* case 196 F. 2d 103, (ROB 13) is inapposite here. Here, the difference between the patented composition of Switzer’s and Radiant’s accused composition is the same difference that distinguished the

patented resin from the resins of the prior art. Switzer is not now endeavoring to enlarge the scope of the patent claims to include the accused 4-C resins as an infringement; the same limitation in the claims that distinguishes the patented resins from the prior art resins, including the Japanese resin, is the limitation that the District Court found to be met by the accused pigments and by the 7-4-1 resins. Switzer is in no way seeking to enlarge the claims in suit beyond the delineation given them by this Court when it adjudicated the original accused Radiant pigments to be in infringement (299 F. 2d 160).

The limitation, "substantially insoluble in aromatic hydrocarbon solvents", is here supported by the same quick qualitative test that distinguished the adjudicated resins, and now distinguishes the accused pigments and the 7-4-1 resins, from the prior art Japanese resin.

The finding of the District Court that the 7-4-1 resins utilize sufficient melamine by itself to render such resins substantially insoluble in aromatic hydrocarbon solvents is not a legal but a factual finding based upon the same quick qualitative test that this Court surely had in mind when referring in its former decision to a "simple, clear test".

Furthermore, in the cited case, the 7th Circuit Court of Appeals reached the decision that it did on the basis that the legal issues of the doctrine of equivalency and also of estoppel were there involved. This Court (348 F. 2d 244, 246) rejected the doctrine of equivalency that Switzer previously urged as justifying a decision that the accused pigments infringed the patent in suit. Here, "the sole question" is purely and simply a factual issue.

In the *U. S. v. Parke, Davis* case (362 U. S. 29) which was an anti-trust case, the Court held that Rule 52 did not require "affirmance of the District Court's ultimate

finding that respondent did not violate the Sherman Act because that conclusion was based on an erroneous interpretation of the standard to be applied.

Here, this Court provided the standard to be applied, viz., the “simple, clear test” that had been used in the original trial to evaluate the substantial insolubility of MSF resins in aromatic hydrocarbon solvents. The District Court applied such standard to the factual evidence before it, evaluated the conflicting testimony of the “live” witnesses and made its fact findings accordingly.

It is these fact findings that Switzer submits are protected by Rule 52(a). They are not “clearly erroneous” and they are based upon the testimony of “live” witnesses.

In *U. S. v. General Motors*, cited by Radiant as appearing in 16 L. Ed. 2d 415, now reported in 86 S. Ct. 1321 (1966), the Supreme Court referred to and followed its previous *Parke, Davis* decision (362 U. S. 29, 44-45). Before the portion quoted by Radiant (ROB 13), the Supreme Court pointed out that the rationale behind Rule 52(a) plays only a restricted role where the case “did not unfold by the testimony of ‘live’ witnesses.”

Here the case did unfold by the testimony of “live” witnesses. Furthermore, contrary to the showing in the cited case, Radiant is asking that this Court “contradict the Trial Court’s findings of *fact*, as distinguished from its conclusionary ‘findings’.” (86 S. Ct. 1321, 1329 fn 16).

In view of the foregoing distinctions from the grounds upon which the Supreme Court rested its decisions in the cited case, Switzer respectfully submits that Rule 52(a) should here be given full effect and the fact findings of the District Court affirmed.

Summary of Switzer's Position as to Radiant's Questions 1 and 2.

(1) Had the "sole question" been a question of law, this Court would not have remanded; it would have decided the question itself. By its "delineation" of the scope of the limitation in the claims in suit, this Court eliminated any legal question from what it instructed the District Court to determine on remand. Consequently, the fact findings of the District Court should not be disturbed.

(2) Radiant should not be permitted to raise for the first time on this appeal the issue involved in its Question 2 of the alleged invalidity of the claims for non-compliance with Section 112 of the Patent Statutes. That issue was not raised by Radiant in the evidentiary hearing or in Respondent's Post Trial Memorandum of Points and Authorities Relative to Facts of Case, filed by Radiant following the evidentiary hearing. The District Court had no occasion to and did not pass upon the issue raised by Question 2.

RADIANT'S QUESTION 2.

At this late date, Radiant attempts to present a second question to this Court challenging the validity of the Kazenas patent on the basis of non-compliance with U. S. C. Title 35, Section 112. On the basis of the same record as here and using the same arguments that Radiant used in its unsuccessful Motion for Leave to File Second Petition for Rehearing in March, 1966, Radiant again seeks to have this Court reverse its Judgment of November 16, 1961 affirming the validity of the patent in suit. Radiant's Motion was denied by this Court, without opinion, on April 20, 1966.

Radiant now attempts to inject the same arguments obliquely into this Appeal notwithstanding the fact that

a carefully framed, very restricted factual issue is all that is involved and that this Court, five years ago, laid to rest all of Radiant's defenses against validity including specifically the Section 112 defense. This new attempt of Radiant's, we submit, should be disposed of summarily.

**THE VALIDITY OF THE PATENT HAS BECOME
THE LAW OF THE CASE.**

Orderly judicial procedure requires a finality to decisions of the Appellate Court on the same issues and between the same litigants. The policy behind the rule was stated by this Court in *Woodworkers Tool Works v. Byrne* (9 Cir. 1953), 202 F. 2d 530, 531:

“The rule is grounded in large part on the policy of ending litigation, and in some instances on the want of power in an appellate court to modify its own judgments otherwise than on a rehearing. And it has been pointedly observed that if the practice were not followed, changes in the personnel of the Court would produce confusion. *Clary v. Hoagland*, 6 Cal. 685; *Oakley v. Aspinwald*, 13 N. Y. 500, 501. For a comprehensive statement of the doctrine and for citations of the almost numberless cases bearing on it, see 5 C. J. S. Appeal and Error, Sect. 1821 et seq.; 21 C. J. S., Courts, Section 195 et seq.”

Deviations from this well established principle are few and occur in only the most exceptional cases. Generally speaking, the only exceptions to the principle occur where: (1) there is an intervening decision of a Federal Court of equal dignity, or of a higher court holding directly opposite *on the identical question presented*; (2) there is an intervening controlling decision by a State court of last resort interpreting state law contrary to the interpretation

given it in the previous Federal Court decision; (3) new evidence and new issues* are presented for consideration on the second appeal; or (4) the decision appealed from was not in that stage of finality that it can be said to have been completely adjudicated.

Radiant attempts to slant its arguments to fit (1), (3) or (4) of these remote exceptions. Taking the arguments in order in which they are advanced, the first argument (ROB 45 et seq.) is to the effect that the prior appeal decision was interlocutory and had therefore not reached that stage of finality required by the doctrine of "law of the case". In doing so, Radiant applies an extremely liberal interpretation to the word "interlocutory". In the instant case, the validity of the patent was affirmed some five years ago by this Court, and except for completion of the accounting procedure, that decision is now final and unappealable.

The fact situation presented here finds an exact parallel in *Coleman Company v. Holly Manufacturing Company* (9 Cir. 1959), 269 F. 2d 660. In *Coleman*, this Court had before it an appeal from a judgment for contempt. Appellant nevertheless attempted to reargue the questions of validity and infringement of the patent, but this Court properly resisted this attempt. After reviewing the attempts of appellant to inject these issues in the appeal proceeding, the Court held (p. 664) in language which is precisely applicable here:

"We have spelled out the appellant's contentions in this respect at such length because we are convinced that the appellant, despite its initial lip-service to the weight to be given to this Court's previous holding

* Here the same issue was fully tried and there was no new evidence that Radiant could not have presented at the original trial. The Trial Court denied Radiant's post-trial motions for new trial to bring in much the same evidence (*e.g.*, that with regard to the benzene test, OR 211-219), and this Court affirmed such denial (299 F. 2d 160, 169).

that the patent in suit is valid and has been infringed, is still unregenerate and unconvinced. On the adjudicated issues of validity and infringement, the appellant's corporate head is bloody but unbowed.

“The point that we are here making is not a technical one. It relates to a salutary principle, firmly imbedded in the law. Again and again we are told that ‘There must be an end to litigation’, and yet attorneys still seek to relitigate adjudicated issues.

“For a century and a half, our Supreme Court has hammered home the principle that, on a second appeal, the higher court is confined to a consideration of the proceedings that took place in the trial court after the mandate in the first case was handed down. *Matters that were adjudicated on the first appeal are no longer open to re-examination.*” (Emphasis supplied.)

The fact situation in the *Marconi* case, (*Marconi Wireless Co. v. U. S.* (1943), 320 U. S. 1), is inapposite. In that case a Commissioner found that one claim 16 of the patent defined new and useful subject matter, and that defendant's apparatus came within the terminology of that claim. The defendant filed no objections to the Commissioner's findings, nor did it make any contention that such claim was invalid and not infringed. After the decision of the Court of Claims holding the claim 16 to be valid and infringed, the case was referred back to the Commissioner for an accounting. At that time, defendant offered prior art (previously of record) not as evidence to show invalidity but only to show justification for the accused structure. The United States Supreme Court, on certiorari, *acting as the first appellate body* under the special practice relating to the Court of Claims, held that while this same evidence had been before the Court of Claims, such evidence may not have been considered by the Court of Claims when it held claim 16 valid and infringed (p. 47).

Here, the question of indefiniteness of the claims has been fully considered and decided by both the District Court and the Court of Appeals (Appellant's Opening Brief, on the first appeal, specified as Error No. 32, failure of the patent claims to comply with 35 U. S. C., Section 112).

Simmons Co. v. Grier Bros. Co. (1922), 258 U. S. 82 is not a precedent favorable to Radiant's position. In that case, there were conflicting decisions rendered by Courts of Appeal of two different circuits on the validity of the same patent. Such a situation brings into play the above-mentioned exception (1) to the "law of the case" doctrine.

In *United States v. U. S. Smelting Co.* (1950), 339 U. S. 186, there was a decree for a preliminary injunction, not appealed, which was held by the Supreme Court not to constitute the law of the case because it was not a final judgment. The facts of that case are wholly inapplicable to the fact situation presented here.

Connor v. New York Times Company (5 Cir. 1962), 310 F. 2d 133 arose out of a previous interlocutory appeal overruling a motion to quash service of process. This case was held to deviate from the "law of the case" doctrine because, first, there was not a final judgment involved, and, second, there was an intervening decision of the State Supreme Court creating a new situation.

The second point urged by Radiant (ROB 47 *et seq.*) is that the Section 112 defense was not fully considered and adjudicated in the first opinion. This argument can be fully answered by reference to the opinion of this Court, 299 F. 2d 160, where at page 166 it held:

"Nor can it be said that this failure to specify the critical limit precisely results in a fatal vagueness of description. The claim must be sufficiently clear to allow others to reproduce the result at the end of the monopoly period and to enable contemporary inventors to ascertain whether or not they are infringing.

“Upon this point the District Court concluded:

‘When the general description, the specific examples, and the claims are read together, the invention is so plainly defined that no one skilled in the art should have any difficulty in practicing it.’

“The record supports this statement. *There is testimony to the effect that ‘sufficient melamine to render the resin substantially insoluble’ is a simple, clear test for an ordinary chemist to perform* and one which does not require extensive experimentation in order that the precise critical limits be ascertained in a particular case.

“Under such circumstances, the fact that some preliminary testing is required does not render the claim invalid for *vagueness*.” (Emphasis supplied.)

Thus, this Court has previously ruled upon the sufficiency of the patent to meet the standards set by Section 112. This issue is no longer open to Radiant on this appeal.

The third point argued by Radiant (ROB 49 *et seq.*) is that there has been a significant change in facts and circumstances warranting a review of the earlier decision. This is based upon the spurious premise that the testimony during the evidentiary hearing was at variance with the evidence adduced during the original infringement trial.* We have fully refuted this contention in our reply to Question 1 in the preceding portion of this brief, and we shall not repeat those arguments here.

Lastly, Radiant argues (ROB 75 *et seq.*) that intervening case law requires a reexamination of the decision on

* As was held in *Coleman Company v. Holly Manufacturing Company* (9 Cir. 1954), 269 F. 2d 660, 665, where appellant urged this Court to “re-assess the evidence and find the District Court weighed-it wrongly.”

“This under hornbook rules we cannot do. Where, as here, there is substantial conflict in the evidence, a court of appeals can not substitute its judgment for that of the trial court.”

the original appeal. In point of fact, Radiant's so-called "sounder cases . . . since the earlier appeal" which bear upon the Section 112 defense are strictly reaffirmations of case law that existed long prior to the decisions handed down by this Court in this litigation.

Radiant can find little solace in the case of *Nelson v. Batson* (9 Cir. 1963), 322 F. 2d 132. In that portion of the opinion which dealt with Section 112, the Court applied the test laid down by two old Supreme Court cases: *Brooks v. Fiske* (15 How. 212, 214-215 (1853) and *Evans v. Eaton*, 7 Wheat. 356, 434 (1822). There is nothing in the *Nelson* case which would indicate any deviation from the standards laid down in those Supreme Court cases decided more than one hundred years ago.

The First Circuit case of *H. C. Baxter & Bro. v. Great Atlantic & Pacific Tea Company* (1 Cir. 1965), 352 F. 2d 87 was a *per curiam* affirmance of the opinion of the District Court in Maine. Reference to the District Court's opinion (236 F. Supp. 601, 612) shows that the Court applied the reasoning in the old *General Electric* case (304 U. S. 364) in arriving at its conclusion. The most recent case cited by that District Court in discussing the proposition of indefiniteness was a 1943 case and the earliest was a Supreme Court decision of 1847. The *Baxter* case evidences no intent to depart from the principles set forth in these citations and it would be frivolous to say that this decision in some way modifies the long-standing law on the subject of the extent to which the "law of the case" can be disregarded.

The patent involved in *McCulloch Motors Corporation v. Oregon Saw Chain Corp.* (S. D. Cal. C. D. 1964), 234 F. Supp. 256 was held invalid on the basis of the *General Electric* case which the Court characterized as the leading case on the subject (234 F. Supp. 259). The patent here in

suit has already successfully met this challenge. Indeed, Judge Merrill speaking for this Court (299 F. 2d 160, 166), devoted almost an entire page to a discussion of the *General Electric* case and specifically held:

“In the *General Electric* case, the effect of the functional language was to broaden the claim to include *all* grains of whatever size or shape so long as they would accomplish the desired result. In our case the critical area is not enlarged in such a fashion. The critical point remains the same for each melamine compound used. It simply is not specified. But whether specified or unspecified the scope of the claim is precisely that of the invention.” (Emphasis by the Court.)

The case of *Johnson & Johnson v. Kendall Company* (7 Cir. 1964), 327 F. 2d 391 cited the *General Electric* case, *supra*, as the sole authority for the proposition that the claim may not be functional at the exact point of alleged novelty. Considering that the Seventh Circuit Court did not even base its decision of patent invalidity on this section of the statute, one wonders how counsel for Radiant can seriously urge that the *Johnson & Johnson* case is that type of intervening decision which would require or even justify a relaxation of the “law of the case” doctrine.

In *AR Inc. v. Electro-Voice Incorporated* (7 Cir. 1962), 311 F. 2d 508, the Court affirmed a District Court finding of invalidity mainly on the basis of lack of invention, but also considered that the claims did not meet the measure of definiteness required by the *General Electric* case. There is nothing in this decision which would indicate a departure from or an extension of the *General Electric* case. Since this Court has already found that the claims at bar satisfy the standards of definiteness set forth in the *Gen-*

eral Electric case, the *AR* decision is not pertinent to any issue presented in this Appeal.

The case of *Marshall v. Procter & Gamble Manufacturing Co.* (D. C., Md. 1962), 210 F. Supp. 619 dealt with claims to a cake of soap and to the method of making it. The Court in that case found certain phrases in the claims, such as "good", "highly" and "excellent" to be indefinite. In support of its position, the Court relied upon the *General Electric* case, *supra*, and other cases which had been handed down long before the present case went through its original trial, and even before the patent in suit issued.

In summary, Radiant has cited no case which could be considered an "intervening" case justifying a reexamination of the specific holding of definiteness under Section 112 made by this Court in its 1961 decision.

CONCLUSION

Based upon the foregoing facts and arguments, and upon the clear and unequivocal findings of fact of the District Court, Switzer respectfully submits that the District Court's Decision should be affirmed in all respects; that Radiant should be adjudged in contempt because its infringing 4-C pigments are in violation of the Writ of Perpetual Injunction, dated May 2, 1962; and that this Court should reaffirm its 1961 decision as to the validity of the patent in suit.

Switzer further submits that it is entitled to treble damages on the grounds that Radiant's infringement has been willful and deliberate (35 USC Sec. 284) and is entitled to the allowance of reasonable attorneys' fees under Sec. 285.

Respectfully submitted,

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Dated at Chicago, Illinois,

August 31, 1966.

CERTIFICATE OF COUNSEL.

I certify that, in connection with the preparation of this brief I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

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